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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,437	12/17/2001	Stephen A. Johnston	UTSD:736US/MBW	2358

7590 07/09/2004
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EXAMINER

FORD, VANESSA L.

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,437

Applicant(s)

JOHNSTON ET AL.

Examiner

Vanessa L. Ford

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-61 and 74-82 is/are pending in the application.
- 4a) Of the above claim(s) 27, 28, 33, 35, 40, 42, 76, 77, 80 and 81 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 25,26,29-32,34,36-39,41,43-61,74,75,78,79 and 82.

DETAILED ACTION

Election/Restriction

1. Applicant's response to the Restriction requirement and amendment filed on April 14, 2004 is acknowledged. Applicant's election of Group III with claims 25-61 is acknowledged. Applicant further elected SEQ ID NO: 9, with traverse to be examined in the invention. Claims 1-24 and 62-73 have been cancelled. Claims 74-82 have been added.
2. Upon further consideration, it is the position of the Examiner that the Applicant's election of Group III, claims 25-61 and newly submitted claims 74-82 contains multiple independent and distinct inventions and is therefore subjected to a new Restriction requirement.
3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 25, 33, 39-51, 74-75 and 82 drawn to method of immunizing an animal comprising administering at least on *Chlamydia* antigen classified in class 530, subclass 300. Further election of a single bacterial species and further election of a single SEQ ID NO: corresponding to a second *Chlamydia* antigen (SEQ ID NO:) is required.

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Group II. Claims 26-32, 34-38 and 76-81 drawn to a method of immunizing an animal comprising administering DNA, cDNA or sequenced genes of *Chlamydia*, classified in class 536, subclass 23.1. Further election of a single SEQ ID NO: corresponding to a first clone and a single election of a single SEQ ID NO: corresponding to a second clone is required.

Group III. Claims 52-61 are drawn to a method of preparing a cloned expression library, classified in class 435 subclass 91.5.

4. Groups I, II and III are different methods. They differ because they have different goals, require different method steps and parameters.

5. In the event applicant elects Group I, claims 25, 33, 39, 40-51, 74-75 and 82 applicant is required to elect a single species of bacteria to be examined. Claims 25, 33, 39, 40-51, 74-75 and 82 recite distinct species of bacteria based on structural differences and are patentably distinct one from another.

Species A) *Chlamydia psittaci*

Species B) *Chlamydia pneumoniae*

Species C) *Chlamydia* species other than *C. psittaci* or *C. pneumoniae*

Species D) a non-*Chlamydia* species,

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6. In the event applicant elects Group I, claims 25, 33, 39, 40-51, 74-75 and 82 applicant is required to elect a single species of second *Chlamydia* antigen recited in claim 42 to be examined. Claims 25, 33, 39, 40-51, 74-75 and 82 recite distinct species of second *Chlamydia* antigen (SEQ ID NOs.) based on structural differences and are patentably distinct one from another.

7. In the event applicant elects Group II, claims 26-32, 34-38 and 76-81 applicant is required to elect a single species SEQ ID NO: corresponding to a first clone (polynucleotide) to be examined. Claims 26-32, 34-38 and 76-81 recite distinct species of clone based on structural differences and are patentably distinct one from another.

8. In the event applicant elects Group II, claims 26-32, 34-38 and 76-81 applicant is required to elect a single species of SEQ ID NO: corresponding to a second clone (polynucleotide) to be examined. Claims 26-32, 34-38 and 76-81 recite distinct species of clone based on structural differences and are patentably distinct one from another.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. Because these inventions are distinct for the reasons given and have acquired a separate status in the art because of their recognized divergent subject matter as shown by their different classification, restriction for examination purposes as indicated is proper. Moreover, in the absence of restriction it would place an undue search and examination burden on the examiner.

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10. Applicant is advised that the reply to this requirement to be complete must include an election of invention to be examined even though the requirement be traversed (37 CFR 1.143).

11. Applicant is reminded that upon that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(h).

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12. Any inquiry of the general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Office Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for the Group 1600 is (703) 872-9306.

Any inquiry concerning this communication from the examiner should be directed to Vanessa L. Ford, whose telephone number is (571) 272-0857. The examiner can normally be reached on Monday – Friday from 9:00 AM to 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached at (571) 272-0864.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Vanessa L. Ford
Biotechnology Patent Examiner
July 1, 2004



MARK NAVARRO
PRIMARY EXAMINER